

## **REMARKS**

It is our understanding that claims 1-34 remain pending in this application.

### **Items 1-2 (Initial items “1” and “2” in the Action):**

These are informational in nature and are understood to require no reply.

### **Item 3 (Response to Arguments, obviousness-type provisional double patenting rejection):**

A Terminal Disclaimer is provided herewith. Applicant does not agree with the Examiner's analysis or conclusion that this is appropriate but, since this will have only very minimal effect on the ultimate patent rights in either of the applications at issue, we pragmatically now disclaim and render this issue moot.

### **Item 4 (Response to Arguments, §102 and §103 rejections):**

Respectfully, the Examiner clearly still does not understand some of Applicant's remarks.

The Action here is first notable in what it does not discuss. The remarks here fail to respond to Applicant's Preliminary Comments in the prior Response (pg. 3, ln. 7-26). Next, the Action here also fails to respond to some of Applicant's remarks how numerous elements/limitations in the present claims are not taught or reasonably suggested by the cited references. See e.g., Applicant's remarks at pg. 3, ln. 27 to pg. 4, ln. 2, which stand un-rebutted. We remind the Examiner that both the prima facie cases for anticipation and obviousness require showings that all of the elements/limitations are present in the references. We submit that such showings have simply not been made and/or now stand rebutted.

Turning to what the Action here does state, it starts by stating:

*As per claim 1, ... (a) Applicant asserts that Garib does not teach "the email includes an authenticity mark including originator identifier and encrypted data". Examiner respectfully disagrees because an originator identifier can be considered as one type of identifiers that can uniquely distinct the email originator such as either the sender / source true identifier or a digital signature that can be reasonably assured the identity of the sender ...*

Respectfully, however, the Examiner's analysis here is logically flawed.

What Applicant's originator identifier might be "*considered as*" is irrelevant. What is relevant here is whether Garib teaches or reasonably suggests Applicant's originator identifier, and the language of the Action quoted above does not support that.

Continuing, the Action immediately next states "... - *in light of that, Garib teaches ....*" This leaves the Examiner's rationale unclear. Is the Examiner using 20/20 hindsight based on Applicant's application to interpret Garib, and then with circular reasoning concluding that Garib teaches Applicant's claimed invention? Or is the Examiner taking official notice of facts not in Garib, and then combining these with Garib to support the rejection here?

The use of 20/20 hindsight is improper, as affirmed in thousands of case law examples and as extensively discussed in the MPEP. Alternately, if the Examiner is taking official notice, that needs to be clearly stated for the record. Furthermore, it is an applicant's prerogative to challenge an examiner's use of official notice and, in the interest of expediting this prosecution, we provisionally do so now. If the Examiner's position is that a digital signature is equivalent to Applicant's authenticity mark, we call upon the Examiner to cite a specific example of such a digital signature, so that Applicant has reasonable opportunity to argue the respective specific differences in the elements, limitations, and uses of an authenticity mark over such an exemplary digital signature. Yet furthermore, if the Examiner is taking official notice, we note that such in combination with Garib cannot procedurally support a §102 rejection.

Continuing, the Action states [Garib teaches]:

[1] "*authenticity means ... (Garib: Column 3 Line 47 - 52)*" and Garib also teaches [2] "*the message hash value is appended to the unencrypted message and is thereafter encrypted along with the message (Garib: Column 6 Line 30 - 35)*" and [3] "*data encrypted with the private key can only be decrypted with public. key (Garib: Column 4 Line 49 - 50)*" - Examiner notes [4] the recipient must be able to extract the sender (or source) identifier from the received email message in order to use the correct public key corresponding to the sender (or source). [5] Therefore, Garib does teach the email includes an authenticity mark including originator identifier and encrypted data and as such Applicant's arguments are respectfully traversed. (underline emphasis in original, double underline emphasis added)

With respect to [1] and [3], we totally agree. However, with respect to [2], this has no relevance to the present claims – none of them recite any kind of hash, much less a message hash value, or such that gets encrypted, or all of such with a message. Respectfully, if the Examiner is trying here to argue that Garib accomplishes the same result as Applicant's claimed invention (which it does not), Garib's reliance on [2] clearly shows that Applicant's claimed invention is at

the very least patentable under §101 as an improvement over Garib because it does not require at least one element/limitation which Garib teaches as necessary.

With respect to [4], this again appears to be the Examiner using 20/20 hindsight to interpret or official notice to broaden Garib. Furthermore, the Examiner apparently is unable to cite support in Garib for his assertion here, so he simply conjecturally argues that something “must” happen. Respectfully, to support a prima facie case in this context a references needs to be cited that teaches or reasonably suggests that something does happen.

In summary and with respect to [5], we urge that the Examiner’s conclusion here is wrong because he has not shown that Garib teaches any of an authenticity mark, originator identifier, or encrypted data that are equivalent to those in Applicant’s claims.

Continuing further, the Action here states:

*Applicant asserts "employing PKI digital signatures is impractical with e-mails in bulk and is simply impossible if recipients are not set-up beforehand. In PKI a sender always needs a recipient's public key before a message can be sent and the present invention is not subject to these limitations (remarks: Page 4 / 6th Par)". Examiner respectfully asserts Applicant's argument has no merit since the alleged limitation has not been recited into the claim. (emphasis in original)*

Respectfully, the Examiner does not seem to have grasped the structure of Applicant’s argument. Summarizing generally, our point was and is that Garib does not provide all of the benefits that Applicant’s claimed invention does, therefore the elements and limitations in Garib cannot be equivalent to those in Applicant’s claims. Summarizing more specifically, Applicant’s independent claims recite encryption and decryption. One of ordinary skill in the art reading such will appreciate that both symmetric and asymmetric encryption are therefore encompassed by the claims. One of ordinary skill in the art will also be aware that symmetric and asymmetric encryption provide different benefits and disadvantages. In contrast, Garib teaches asymmetric (PKI, public/private key cryptography). It therefore follows, once again, that Applicant’s claimed invention is at the very least patentable under §101 as an improvement over Garib.

**Item 5 (Responsive to the 2<sup>nd</sup> item “1” in the Action, Double Patenting):**

A Terminal Disclaimer is provided herewith. Remarks on this have been provided, above.

**Item 6 (Responsive to the 2<sup>nd</sup> item “2” in the Action, the §102 rejection):**

The Action here repeats the language of Item 4 in the prior Action, essentially verbatim. In reply, Applicant incorporates by reference its remarks from the prior Response and asks for reconsideration of those remarks.

**In summary, we reiterate that “*Garib is teaching the generation and matching of two hash values*” and the present claims do not recite any hash values. Garib teaches different elements and limitations, it uses different principles of operation, and it products different results than Applicant’s claimed invention.**

**Item 7 (Responsive to Items 3-5 in the Action, the §103 rejections):**

The Action here repeats the language of Items 5-7 in the prior Action, essentially verbatim. In reply, Applicant incorporates by reference its remarks from the prior Response and asks for reconsideration of those remarks.

**CONCLUSION**

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the double patenting rejection is now moot, that the §102 rejection is shown to be unfounded on the prior art reference cited, and that the §103 rejections have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,



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